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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

STIPEK

Serial No.: 10/643,448

Filed: August 18, 2003

Atty. File No.: 3725-901-CON

For: "FURNITURE WITH MOLDED
FRAME"

Group Art Unit: 3636

Examiner: VU, Stephen A.

RESPONSE TO RESTRICTION
REQUIREMENT

Express Mail Label: EV368038210US

Mail Stop: Amendments

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313

Dear Sir:

Applicant submits this response to Restriction Requirement and Amendment to address the Office Action having the mailing date of April 21, 2004. Although Applicants do not believe that any fees are due based upon the filing of this Preliminary Amendment, please charge any such fees to Deposit Account 19-1970.

In the First Office Action dated April 21, 2004, the Examiner issued a restriction requirement under 35 U.S.C. 121. Specifically, the Examiner concludes that this application contains claims directed to two patently distinct species of the claimed invention namely Species I (figures 1A - 7F) and Species II (Figures 9C - 9D).

Applicant respectfully traverses the Examiner's Restriction Requirement. In short, the Examiner fails to satisfy the burden placed on him to establish that restriction is both authorized and appropriate.

The Manual of Patent Examining Procedures (MPEP) requires the establishment of two criteria to authorize restriction between patentably distinct inventions. First, the inventions must be independent (see MPEP 802.01, 806.04, 808.01) or distinct as claimed (see MPEP 806.05 - 806.05(i). Second, there must be a serious burden on the Examiner absent the restriction (see MPEP 803.02, 806.04(a) - 805.04(i), 808.02).

The burden of establishing these requirements is on the Examiner. Indeed, the MPEP explicitly states that: "The particular reasons relied on by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given." MPEP 816. Similarly, MPEP 803 bluntly requires that "Examiners must provide reasons and/or

examples to support conclusions.” MPEP 803 (emphasis added). Additionally, “every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween.” MPEP 808.

Here, the Examiner concludes that the alleged two species are distinct, but provides no reasons or examples to support those conclusions. With no basis provided for the conclusion that the alleged species are distinct, or for insisting on restriction between the alleged species, there is nothing for Applicant to rebut and therefore no real opportunity to respond on the merits of the restriction. Applicant is left to guess as to why the Examiner believes the alleged species are distinct. For this reason alone, the restriction requirement should be withdrawn.

Also, the Examiner fails to address the purported serious burden in examining this case as filed that compels restriction. Again, the Examiner fails to meet his burden of establishing a prima facie case requiring restriction and there is nothing for Applicant to rebut. The restriction requirement should be withdrawn.

In addition, MPEP 808.02 and 803.01 require that the Examiner’s reasons for restriction must include an appropriate explanation of 1) separate classification of the alleged distinct inventions; 2) separate status in the art when they are classified together; or 3) a different field of search for each of the alleged inventions. Again, because the Examiner has failed to state any reasons for insisting upon restriction after establishing that the alleged species are distinct, Applicant is not able to respond.

The Patent statutes allow, but do not mandate, the Office to restrict the application to one of the two or more independent and distinct inventions claimed therein. 35 USC 121. Therefore, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.01 (emphasis added). Also, in recognition of this discretionary authority, the MPEP admonishes that “it becomes very important that the practice under this section be carefully administered.” MPEP 803.01.

Applicant submits that the Examiner has failed to meet his burden for establishing that the application should be restricted at all, let alone into the two alleged species. Accordingly, Applicant respectfully requests that the restriction requirement as to the alleged distinct species be withdrawn.

Application No. 10/643,448

As required by the rules, Applicant provisionally elects Species I, which Applicant believes is represented by Claims 1-33 and 36-57. However, Applicant respectfully submits that the application should proceed to examination based upon all of the pending claims, namely Claims 1-57.

Respectfully submitted,
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